

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by European Patent Application No. 418398 to Neko et al. ("*Neko*"); and rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication No. 2001287254 to Moriwaki ("*Moriwaki*") in view of *Neko*.

Applicants have amended claims 1 and 7, and claims 1-14 remain pending.

Applicants respectfully traverse the rejection of claims 1-14 under 35 U.S.C. § 102(b) as anticipated by *Neko*. In order to properly establish that *Neko* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a waveform monitoring apparatus including, for example:

a hydraulic cylinder . . .
a sensor . . .
a determinant . . .
a marking applier, applying a marking to an excess portion of the measured value waveform determined by the determinant,
wherein the marking is thicker than other portions of the measured value waveform that do not exceed the reference pressure.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

(emphasis added). *Neko* does not teach or suggest every element of the claimed invention.

The Examiner alleges that *Neko* discloses “a marking applier (col. 11, lines 11-39) applies a marking (value ER) to an excess portion of the measured value waveform determined by the determinant” (Office Action at page 2). Even assuming that this is correct, which Applicants do not concede, *Neko* does not teach “the marking is thicker than other portions of the measured value waveform that do not exceed the reference pressure.”

Neko discloses an apparatus that counts the number of times (value ER) that the difference between the reference resin pressure and the actual resin pressure exceeds the allowable value (col. 11, lines 11-27). Thus, in one sampling period, if the difference between the reference resin pressure and the actual resin pressure exceeds the allowable value, the apparatus “updates the value ER in the defective sample counter to the value ‘ER+1,’ and then determines whether or not the updated counter value ER is not less than the allowable frequency N” (col. 11, lines 20-24). If the value ER exceeds the allowable frequency N before the final sampling period, the apparatus delivers a defective article signal (col. 11, lines 40-48). If the value ER does not exceed the allowable frequency N at the final sampling period, the apparatus delivers a conforming article signal (col. 11, lines 40-48).

Applicants submit that value ER merely represents the frequency that a defective pressure is detected, and does not vary with the value or size of the excess portion of the actual resin pressure. Even assuming that value ER constitutes the claimed marking, which Applicants do not concede, *Neko* does not teach or suggest the claimed

the claimed combination of elements including, for example, "the marking is thicker than other portions of the measured value waveform that do not exceed the reference pressure," as recited in claim 1.

Accordingly, *Neko* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons. Claims 2-6 and 13 are also allowable at least due to their depending from claim 1. Independent claim 7, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1 and is thus allowable over *Neko* for at least the same reasons discussed above in regard to claim 1. Claims 8-12 and 14 are also allowable at least due to their depending from claim 7.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-14 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established with respect to this claim.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, neither *Moriwaki* nor *Neko*, taken alone or in any proper combination, teach or suggest each and every element recited by claims 1-14.

The Examiner alleges that *Moriwaki* discloses, “a marking (outlying observation) is applied to an excess portion of the measured value waveform and displayed on the display including variances” (Office Action at page 4). Even assuming that this is correct, which Applicants do not concede, *Moriwaki* does not teach “the marking is thicker than other portions of the measured value waveform that do not exceed the reference pressure.”

Applicants continue to submit that outlying observation merely indicates that an abnormality is detected. When outlying observation is detected, the apparatus disclosed in *Moriwaki* can display the outlying observation on a display, print out the outlying observation using a printer, store the outlying observation in a recordable recording device, perform statistics processing (e.g., computing a variance, the average, the maximum, the minimum, an integral value, the rise time, a fall time, and a rate of change), output the processing result data, display the processing result data on a display, and print the processing result data using a printer (paragraphs 0009-0013).

Even assuming that *Moriwaki* discloses a marking applier, which Applicants do not concede, *Moriwaki* does not teach or suggest the claimed the claimed combination of elements including, for example, “the marking is thicker than other portions of the measured value waveform that do not exceed the reference pressure,” as recited in claim 1.

According, the Examiner’s application of *Moriwaki* and *Neko* does not satisfy the tenets of a proper 35 U.S.C. § 103(a) rejection. The rejection of claim 1 under 35 U.S.C. § 103(a) is therefore improper. Claims 2-6 and 13 depend from claim 1 and are thus also allowable for at least the same reasons as claim 1.

Independent claim 7, though of different scope from claim 1, recites limitations similar to those set forth above with respect to claim 1. Claim 7 therefore allowable for at least the reasons presented above. Claims 8-12 and 14 are also allowable at least due to their dependence from claim 7.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. Pending claims 1-14 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 25, 2007

By: /David W. Hill/
David W. Hill
Reg. No. 28,220